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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,224	11/28/2000	Minoru Arakawa	723-985	7826

7590 05/08/2003
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1100 North Glebe Road, 8th Floor
Arlington, VA 22201

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/08/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/7/26,224

Applicant(s)

ARAKAWA ET AL.

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-9 and 10-19, in Paper No. 7, October 11, 2002 is acknowledged. Claims ~~20~~ 20-23 are hereby withdrawn from consideration.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, digital camera remotely located from the base unit while connecting to the game system of claims 4 and 14; and a slot in the base for receiving camera unit of claims 7 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the microphones in Figures 6-8 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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4. Claims 1-9 are objected to because of the following informalities:

In claim 1, line 3, the semicolon (;) should be changed to a comma (,).

Appropriate correction is required.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 8, 10, 13, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka et al. 6,120,379 or 6,540,615.

Tanaka et al. teaches a gaming system comprising a processing system to execute a video game program; player controls operable by a user to generate video game control signals; a connector for connecting a digital camera accessory to the game system, wherein the digital camera comprising: an image sensor for capturing video images; communication circuitry configured to transmit the captured video images; a connector electrically connects the digital camera accessory to the game system; a display for displaying the received video images; wherein the digital camera accessory comprises a memory for storing a video game program executable by the processing system.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4-7, 11, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. 6,120,379 or 6,540,615 in view of Parulski et al. (5,666,159).

Tanaka et al. teaches all limitations of claims 1, 8, 10, 13, and 18. Tanaka et al. does not explicitly teach communication circuitry is configured to receive transmitted video images (claims 2 and 11); digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit (claims 4 and 14); communication circuitry configured to transmit the captured video images is contained in the camera unit (claims 5 and 15); the base unit comprising communication circuitry configured to receive the captured video images transmitted from the camera unit (claims 6 and 16).

Parulski et al., however, teaches an electronic camera system with programmable transmission capability comprising communication circuitry is configured to receive transmitted video images; digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit; communication circuitry configured to transmit the captured video images is contained in the camera unit; the base unit (receivers A, B, C. Fig. 1, see the abstract and 5:16-24) comprising

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communication circuitry configure to receive the captured video images transmitted from the camera unit. See also, Figs. 1-11 and columns 1-5). Note, the limitation of a housing of base unit having a slot for receiving the camera unit (claims 7 and 17) is design choice since this does not bring unexpected result. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Tanaka et al.'s portable game machine having image capture capability by using wireless technology for capturing and transmitting images, as taught by Parulski et al., to come up with a more user friendly video game system which provides more interactive capability.

9. Claims 3, 9, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. 6,120,379 or 6,540,615 in view of Fukuoka (5,754,227).

Tanaka et al. teaches all limitations of claims 1, 8, 10, 13, and 18. Tanaka et al. does not explicitly teach communication circuit configured to receive transmitted video images (claims 3 and 12); and digital camera accessory comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (claims 9 and 19). Fukoka, however, teaches a digital camera having an external input/output interface comprising communication circuit configured to receive transmitted video images; and digital camera accessory comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (8:9-20). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the portable video game

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of Tanaka et al. with a digital camera having controlled audio/video input/output, as taught by Fukoka, to enhance user interactive capability in video game.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 8, 10, 13, and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 6,540,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because both groups claim on the same basic limitations that employ both game system and game accessory comprising a processing system to execute a video game program; player controls operable by a user to generate video game control signals; a connector for connecting a digital camera accessory to the game system, wherein the digital camera comprising: an image sensor for capturing video images; communication circuitry configured to transmit the captured video images; a connector electrically connects the digital camera accessory to the

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game system; a display for displaying the received video images; wherein the digital camera accessory comprises a memory for storing a video game program executable by the processing system.

12. Claims 2, 4-7, 11, and 14-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. Patent No. 6,540,615 in view of Parulski et al. (5,666,159).

Tanaka et al. teaches all limitations of claims 1, 8, 10, 13, and 18. Tanaka et al. does not explicitly teach communication circuitry is configured to receive transmitted video images (claims 2 and 11); digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit (claims 4 and 14); communication circuitry configured to transmit the captured video images is contained in the camera unit (claims 5 and 15); the base unit comprising communication circuitry configured to receive the captured video images transmitted from the camera unit (claims 6 and 16).

Parulski et al., however, teaches an electronic camera system with programmable transmission capability comprising communication circuitry is configured to receive transmitted video images; digital camera accessory comprising a base unit and a camera unit remotely locatable relative to the base unit; communication circuitry configured to transmit the captured video images is contained in the camera unit; the base unit (receivers A, B, C. Fig. 1, see the abstract and 5:16-24) comprising communication circuitry configured to receive the captured video images transmitted from

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the camera unit. See also, Figs. 1-11 and columns 1-5). Note, the limitation of a housing of base unit having a slot for receiving the camera unit (claims 7 and 17) is design choice since this does not bring unexpected result. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Tanaka et al.'s portable game machine having image capture capability by using wireless technology for capturing and transmitting images, as taught by Parulski et al., to come up with a more user friendly video game system which provides more interactive capability.

13. Claims 3, 9, 12, and 19 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,540,615 in view of Fukuoka (5,754,227).

Tanaka et al. teaches all limitations of claims 1, 8, 10, 13, and 18. Tanaka et al. does not explicitly teach communication circuit configured to receive transmitted video images (claims 3 and 12); and digital camera accessory comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (claims 9 and 19). Fukoka, however, teaches a digital camera having an external input/output interface comprising communication circuit configured to receive transmitted video images; and digital camera accessory comprising microphone for detecting sounds, wherein the communication circuitry is further configured to transmit the detected sounds (8:9-20). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the portable video game

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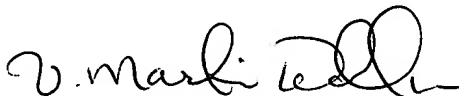
of Tanaka et al. with a digital camera having controlled audio/video input/output, as taught by Fukoka, to enhance user interactive capability in video game.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

BN
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